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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,351	04/08/2004	Markus Hartmann	DT-6789	8136
30377	7590	02/23/2006	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			LANDRUM, EDWARD F	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/820,351	HARTMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Edward F. Landrum	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/23/2004</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. This referring to foreign patent no. DE 19932637.

### ***Specification***

2. The abstract of the disclosure is objected to because of the use of legal phraseology such as "whereby" and "means". Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roe (U.S Patent No. 6,272,757) in view of Bednar et al (U.S Patent No. 6,851,193), hereinafter Bednar.

Roe teaches (see Figures 3-13) a motor driven power saw (10) comprising an elongated housing (12) and a guide system (30) that is removably attached at a tool opening in the nose (16) of the housing (12). The guide assembly (30) has a rounded cross-sectioned elongated member (61) that fits in a slot (22) in the nose (16) of the housing (12). The slot (22) contains a spring-biased adjustment assembly (Col. 4, lines 30-67) with a button (90) and a locking member (82) that locks into one of a plurality of spaced, reduced diameter, locking restrictions (69) found on the elongated member (61). The slot (22) is separate of the opening for the reciprocating blade and has a rounded cross-section. A connecting web (48) is used to attach the end of the elongate member (61) to the shoe (34). The connecting web (48) is spaced outward of the housing (12). The shoe (34) is attached to the connecting web (48) by fastening means (44) so the shoe (34) can be pivoted with respect to the rest of the guide assembly.

Roe teaches all of the elements of the current invention as stated above except the use of two elongate members to connect the shoe to the housing wherein each has a separate recess and are separated by 0.3 to 0.9 times the width of the housing. Furthermore, Roe fails to teach the connecting web being u-shaped or that the connecting web is formed of a bent-punch part.

Bednar teaches (see Figures 8 and 8a) a guide assembly that is attached to the housing of the reciprocating saw in two separate locations. Though the two locations are attached, both are sectioned into the own opening in the housing (see Figure 2). Furthermore, the two locations appear to be separated by .3 to .9 times the width of the housing of the saw.

It would have been obvious to have modified Roe to incorporate the teachings of Bednar to provide two posts to connect the guide assembly to the housing. Two connected in separate locations posts would make the entire guide assembly more resistant to any forces applied perpendicular to the elongate structure of the guide mechanism and any forces attributed to a user pushing the saw into a hard material. Each elongate member could be attached to the shoe via a web as shown in Roe and then connected to opposite sides of the shoe.

Although the modified device of Roe does not explicitly using a u-shaped connecting web the Examiner takes official notice that it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a u-shaped connecting web for the purpose of avoiding the reciprocating saw blade while still providing a support to keep each elongate member from bending or twisting.

Although the modified device of Roe does not explicitly teach making the connecting web by use of a punching operation the Examiner takes official notice that it would have been obvious to design a connecting web made of parts that could be made in standard punching operations. Punching is cheaper, faster, and more efficient than other machining processes and is commonly used for the manufacturing of parts made of metal. Making the connecting web out of punched parts would save time and money.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified device of Roe in view of Mejia (U.S Patent No. 3,528,463).

The modified device of Roe teaches all of the elements of the current invention as stated above except the connecting web being u-shaped.

Mejia teaches (90; see Figure 1) a u-shaped connecting web to connect two elongate arms (82) to the guide shoe (94).

It would have been obvious to have modified the modified device of Roe to incorporate the teachings of Mejia to create a connecting web that connected the two elongate arms together and to the guide shoe while avoiding any reciprocatory or oscillatory movements of the saw blade.

### ***Double Patenting***

6. "Guide means" and "connection means" in SN 10/820,352 does not render obvious the elongate rod-like members with a rounded cross-section in the instant application.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Palm (U.S Patent No. 5,007,172) teaches a circular, elongate connecting arm with depressions spaced at intervals along its surface. Ono (U.S Patent no. 6,308,423) teaches a reciprocating saw with a guide. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward F. Landrum whose telephone number is 571-272-5567. The examiner can normally be reached on Monday-Friday 8-4:30.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EFL  
2/8/2006



  
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